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09/754,411	01/02/2001	Eric D. Bergman	0007056-0053/P5278/ARG	3148

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EXAMINER
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HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

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05/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/754,411

Applicant(s)

BERGMAN ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-9,12-17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 12-17, 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 3/19/07 to the application filed on 1/2/01.
2. Claims 2-3, 10-11, 18-19 are canceled.
3. Claims 1, 4-9, 12-17, 20-27 are pending in the case. Claims 1, 9, 17 are independent claims.
4. The 112, second paragraph rejections of claims 4, 12, and 20 have been withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4-9, 12-17, 20-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rybicki et al. (US Pat No. 5,630,081, 5/13/97, filed 9/7/95) in view of Kucala (US Pat No. 5,832,489, 11/3/98, filed 10/8/97, priority 10/18/95).

Regarding independent claim 1, Rybicki discloses:

- creating an original document on a computer (**col 1, lines 15-25**: the fact that portable computers known as laptop, notebook, or palmtop PC allow the traveler to continue working while on the road or on the plane as in his/her office inherently shows that the original documents are created at the desktop computer at his/her office)
- transferring said original document to a disconnected device, wherein said disconnected device is a portable electronic device capable of performing computations at any location (**col 1, lines 15-25**: the fact that portable computers known as laptop, notebook, or palmtop PC allow the traveler to continue working while on the road or on the plane as in his/her office inherently shows that the original documents are transferred to his/her portable computer, which is a disconnected device capable of performing computations at any location)
- modifying said original document on said disconnected device to form a modified document (**col 1, lines 15-25**: files on the portable PC are modified)
- returning said modified document to said computer (**col 1, lines 15-25**: modified files on the portable PC are transferred to the desktop computer when said traveler returns to his/her office)

Rybicki does not disclose:

- determining one or more modification between said original document and said modified document
- utilizing change tracking software
- determining whether change tracking software on said disconnected device is compatible with the change tracking software on said computer, and
- if the change tracking software on said disconnected device is not compatible with the change tracking software on said computer, utilizing a data translation operation to convert tracked changes to a protocol useable by said computer

Kucala discloses:

- determining one or more modification between said original document and said modified document (col 4, lines 1-20)
- utilizing change tracking software (table 1, col 4, lines 1-20: determining new, updated or deleted records as well as using the comparing result to create a single file that contains all new records, modified records, and unmodified records imply that a change tracking software is utilized)
- determining whether change tracking software on said disconnected device is compatible with the change tracking software on said computer, and if not compatible, utilizing a data translation operation to convert tracked changes to a protocol useable by said computer (col 5, lines 39-51: comparing the palmtop files and the PC files to see if they are identical and do translation if they are not identical; this implies that the palmtop software and the PC software are

compatible when these files are identical; if the file format are non-identical, that means the palmtop software and the PC software are not compatible and a translation of file formats or a conversion of file formats is performed)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kucala into Rybicki since Kucala discloses determining one modification between the original document and the modified document providing the advantage to incorporate into Rybicki for easily adding the documents modified in the portable device to the original document in the desktop computer upon a user desire.

Regarding claim 4, which is dependent on claim 1, Rybicki and Kucala disclose that said disconnected device comprises a PDA (Rybicki: col 1, lines 15-25; Kucala: fig. 1).

Regarding claim 5, which is dependent on claim 1, Rybicki does not disclose determining whether to integrate said modification into said original document.

Kucala discloses determining whether to integrate said modification into said original document (col 1, lines 49-62, col 3, lines 1-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kucala into Rybicki since Kucala discloses determining whether to integrate the modification into the original document providing the advantage to incorporate into Rybicki for effectively synchronizing files between the handheld computer and the desktop computer.

Regarding claim 6, which is dependent on claim 1, Rybicki does not disclose merging said original document and said modified document.

Kucala discloses merging said original document and said modified document (col 3, lines 22-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kucala into Rybicki since Kucala discloses merging the original document and the modified document providing the advantage to incorporate into Rybicki for obtaining the new version of a document at a desktop computer after being modified in part remotely from a portable device.

Regarding claim 7, which is dependent on claim 1, Rybicki discloses said original document was created using an office productivity application (col 1, lines 15-25: files created in the offices implies using an office productivity application).

Regarding claim 8, which is dependent on claim 1, Rybicki discloses said document was modified using a companion application (col 1, lines 15-25: modify a file at the portable PC implies using a companion application).

Regarding claim 25, which is dependent on claim 1, Rybicki does not disclose identifying the differences between the original document and said modified document using change tracking software on the disconnected device, and storing difference information to indicate the identified differences.

Kucala discloses identifying the differences between the original document and said modified document using change tracking software on the disconnected device, and storing difference information to indicate the identified differences (col 4, lines 1-20, col 5, lines 15-50: find matching and perform the compare to identify the difference between the original calendar file and the update calendar file, are performed on the palmtop shows that a software on the palmtop to keep track changes of the documents where the palmtop is a disconnected device).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kucala into Rybicki since identifying said differences using change tracking software on the disconnected device and storing said differences would help to determine whether or not to merge the files of the portable PC and the desktop PC.

Claims 9, 12-16, 26 are for a change tracker of method claims 1, 4-8, 25 and are rejected under the same rationale.

Claims 17, 20-24, 27 are for a computer program product of method claims 1-4, 5-8, and are rejected under the same rationale.

### ***Response to Arguments***

8. Applicant's arguments filed 3/19/07 have been fully considered but they are not persuasive.



Art Unit: 2178

Applicants argue that Kucala does not disclose “determining whether change tracking software on said disconnected device is compatible with change tracking software on said computer” and “utilizing a data translation operation to convert tracked changes to a protocol useable by said computer” since the cited portion (col 5, lines 39-51) says nothing of “change tracking software”, determining change tracking software compatibility, or “a data translation operation to convert tracked changes” where the change tracking software is not compatible (Remarks, page 9).

Examiner respectfully disagrees.

Kucala discloses determining new, updated, or deleted records as well as using the comparing result to create a single file that contains all new records, modified records, and unmodified records (table 1, col 4, lines 1-20). The single file that contains new records, modified and unmodified records with updated records, or deleted records shows that the changes to data are recorded. In other words, changes to data are tracked. This implies that Kucala uses a software for tracking changes to data.

Further, Kucala discloses comparing the palmtop files and the PC files to see if they are identical in file formats and do translation if they are not identical (col 5, lines 39-51).

That means the change tracking softwares on the palmtop and the PC are not compatible, which causes a same file in two different devices look differently in different formats. Performing translation or conversion of the file formats when they are not identical and where the files include modified records shows that a data translation operation to convert tracked changes to a protocol useable by the computer is utilized.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alam et al. (US 6,336,124).

Whitledge et al. (US 6,925,595).

Kelts (US 2002/0112237).

Proulx et al. (US 2002/0124019).

Emmett et al. (US 2002/0129006).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
5/14/07